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July 15, 2005

### REMARKS/ARGUMENTS

Reconsideration and allowance of all the claims of record are respectfully requested.

The applicants sincerely appreciate the courtesies extended by Examiner Boccio to the undersigned during the July 14, 2005 telephone interview regarding the above-identified application. The applicants further appreciate the Examiner's indication during the course of the interview that claim 94, as amended above, appears to patentably distinguish over the applied prior art. A summary of the arguments presented during the course of the interview is included in the remarks set forth below.

In order to expedite the prosecution of this case, the applicants have amended the claims of record to even further distinguish over the applied prior art. It is initially emphasized that the claimed portable data transfer and repository device is not a general purpose personal computing device, like the Palm PC 110, but rather is an independent, intermediary device which receives, for example, the contents of a digital camera memory containing picture image data previously captured by a digital camera and stores this picture image data in a mass storage device for later data transfer to a separate user computer device, such as a user's notebook, laptop or desktop computer.

The claimed invention fulfills an important need and addresses an important application not contemplated by the Palm PC 110 references applied by the Examiner. The features defined by the claims of record allow, for example, a photographer to recover from unexpectedly filling up a camera memory while taking pictures when hiking

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in the wilderness and to conveniently reuse the memory to capture further digital photographs.

Subsequently, after a series of photography excursions, the claimed invention can be used to conveniently transfer captured images to the user's laptop or desktop computer in an environment where the bulkiness of the computer is no longer an issue. Likewise, the claimed invention may be used to transfer previously captured picture image data resident in a user's computer to the repository device for display.

Claims 94-106, 109-120 and 122-132 stand rejected under 35 U.S.C. §103, as being unpatentable over IBM Palm PC 110 Tech Spec. and Press Release and "Japanese Document Summaries PC 110" and the Picture of the IBM Palm PC (1 page), used together as one reference. Additionally, the Examiner rejected claims 107, 108, and 121 under 35 U.S.C. §103 as being unpatentable over these IBM Palm PC 110 references in view of Yamauchi et al. (U.S. Patent No. 6,020,982). The applicants submit that the applied references fail to disclose or suggest the claimed invention as defined in each of independent claims 94, 116, and 125 and the claims dependent therefrom. The claims of record define a unique digital data transfer and repository apparatus and methodology which is neither disclosed nor suggested by the applied references.

Turning to amended claim 94, initially it is noted that the Palm PC 110 cannot be fairly characterized as being a "digital picture image data transfer and repository device for displaying a user's digital photographs." Further, the Palm PC 110 is not a repository device that is embodied in a housing operable to receive digital picture image data and

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being connectable to a user's notebook computer. Rather, the Palm PC 110 is a general purpose user's notebook computer in and of itself. The Palm PC 110 is not described in the documents of record as an intermediary device or as a device which receives, for example, the contents of a digital camera memory containing picture image data previously captured by the digital camera and which stores this picture image data in a mass storage device for later data transfer to a separate user computer device, such as a user's notebook/laptop or desktop computer.

In order to expedite prosecution of this application, claim 94 has been amended to require that the claimed at least one user interface key embodied in said housing includes "a copy key for initiating the copying of the contents of a memory of a digital camera containing picture image data previously captured by said digital camera from said memory of said digital camera to said mass storage device."

Because the Palm PC 110 is a general purpose PC and does not describe the digital picture image data repository application, the Palm PC 110 does not disclose or suggest a copy key which initiates the operation of copying to a mass storage device, the contents of a memory of a digital camera containing previously captured picture image data. Additionally, as set forth in amended claim 94, the Palm PC 110 does not include at least one port operable to receive digital camera picture image data "including a copy of the contents of a memory of a digital camera containing picture image data previously captured by a digital camera."

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Nor does the Palm PC110 include a mass storage device embodied in said housing "having at least one gigabyte of storage" that is operatively coupled to receive and store "said copy of the contents of a memory of a digital camera containing picture image data previously captured by a digital camera" as is required by independent claim 94. Through the use of the copy key referenced, for example, on page 17 of the applicants' application specification, the contents of a digital camera memory such as a flash memory module may be conveniently downloaded to mass storage which is a significant benefit to, for example, the typical vacationer trying to conserve camera memory module usage. (See also application specification at page 18 which describes downloading of picture image data from a camera memory to the repository device mass storage. Likewise, as described, for example, at application pages 25, 26, and 37-39, Figures 6 and 8 depict apparatus for transferring (via, for example, a USB port) the contents of the memory of a digital camera such as would be resident in a digital camera 338 to a mass storage device. Further, Figure 8 and the disclosure related thereto describe the transfer of data in a digital camera portable media 315 to the data repository mass storage device).

Although the Palm PC 110 materials applied by the Examiner describe a digital camera application, the application involves the Palm PC 110 itself "becom[ing] a digital camera". See Japanese Document Summaries at page 2. Such a disclosure does not fairly disclose or suggest a "copy key" which initiates the operation of copying the contents of a memory of a digital camera containing picture image data previously captured to a mass storage device. Further, such a disclosure does not disclose or suggest

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the transfer of the contents of the memory of a digital camera to a mass storage device. It is additionally noted that it does not appear to be physically possible to utilize the Palm PC 110 as a "camera" and at the same time also utilize the optional hard disk module since they both occupy the same device port. Further materials relating to the Palm PC 110 are cited for the Examiner's review in the attached Information Disclosure Statement.

Corresponding to independent claim 94, independent apparatus claim 116 and independent method claim 125 have been amended to, *inter alia*, require "a copy key for initiating the copying of the contents of a memory of a digital camera containing picture image data previously captured by the digital camera to said hard disk drive." For the reasons set forth above, these and other limitations set forth in independent claims 116 and 125 are neither disclosed nor suggested by the applied references.

The Yamauchi reference cited with respect to dependent claims 107, 108 and 121 fails to cure the above cited deficiencies of the Palm PC 110 applied references. As previously explained in detail in conjunction with the applicants' response to the first office action, Yamauchi lacks various features required by each of the claims of record and is a fundamentally different type of device than that which is defined by the claimed invention. Yamauchi does not provide any suggestion for modifying the Palm PC 110 so as to result in the combination of apparatus elements or method steps defined by the claims of record.

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It is submitted that without using applicants' claims as a guide to pick and choose elements of the applied references, there is simply no way that the applied references would be modified to result in the claimed invention.

Even if the Examiner were of the view that it is conceivable that the applied references could be modified to result in the claimed invention, such a modification would not have been obvious within the meaning of 35 U.S.C. §103, unless the prior art suggested the desirability of such a modification. See *In re Gordon*, 773 F.2d 900 (Fed. Cir. 1994) and *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983). Absent any such suggestion, the applicants can only conclude that any continued rejection based upon the applied references must necessarily be grounded upon an improper hindsight reconstruction of the claimed invention using the applicants own disclosure and claims as a guide.

The applicants further note that many of the dependent claims recite features which are not disclosed or suggested by the prior art. The Examiner has repetitively relied on "official notice" as a basis to reject claims without providing an appropriate evidentiary showing in the prior art. Since the independent claims are believed to be in condition for allowance for the reasons set forth above, there is no present need to address any of these issues in detail.

In view of the foregoing, the applicants believe that all the claims are in condition for allowance, and an action to that end is earnestly solicited. If any issues remain to be

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resolved, the Examiner is urged to contact the applicants' attorney at the telephone number identified below.

Respectfully submitted,

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